



The opinion in support of the decision being entered today was  
not written for publication and is not binding precedent of the Board

Paper No. 31

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte ROBERT C. WOHLSEN  
and SUE MCNEILL

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Appeal No. 2005-0743  
Application 09/351,723

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ON BRIEF

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Before THOMAS, RUGGIERO and GROSS, Administrative Patent Judges.

THOMAS, Administrative Patent Judge.

DECISION ON APPEAL

The appellant's have appealed to the Board from the examiner's final rejection of claims 23, 25, 30, 32 and 37. From the generic notice of Appeal filed on April 7, 2003 (Paper No. 23), appellants have indicated at

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the top of page 2 of the brief filed on June 6, 2003 that only claims 23, 25, 30, 32 and 37 are appealed or argued among claims 23-43 remaining in the case and rejected by the examiner in the final rejection.

Representative claim 23 is reproduced below:

23. A method of obtaining a user's identity by voice, comprising:

receiving a set of at least one known grammar and a set of at least one known voiceprint corresponding to a plurality of utterances from each of a first plurality of users;

for each of the first plurality of users, associating the set of at least one known grammar and the set of at least one known voiceprint with an identifier of said user;

receiving at least one utterance from a subject user;

performing a voice recognition on at least one of the at least one utterance received from the subject user, said voice recognition being different from extracting a grammar from a first at least one of the at least one utterance received from the subject user;

responsive to the voice recognition technique, selecting from the first plurality of users a second plurality of users, smaller than the first plurality of users by a factor of at least ten, for which the first voice recognition most closely matches at least one selected from the set of at least one grammar and the set of at least one voiceprint associated with the identifiers of the second plurality of users;

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from the second plurality of users, selecting the user for which a grammar of the first at least one of the at least one utterance received from the subject user most closely matches at least one of the set of at least one grammar associated with the identifiers of the second plurality of users;

verifying a voiceprint of at least one of the at least one utterance has at least a similarity to the set of at least one voiceprint of the selected user; and

responsive to the verifying step, providing the identifier of the selected user as the identifier of the subject user.

The following reference is relied on by the examiner:

Schier 6,246,988 June 12, 2001  
(filing date Feb. 10, 1998)

Claims 25 and 32 stand rejected under the second paragraph of 35 U.S.C. § 112 because, in the examiner's view, the claims are indefinite for failing to particularly point out and distinctly claim the subject matter which appellants regard as their invention. The claims are also rejected under 35 U.S.C. § 103. At the bottom of page 3 of the answer, the examiner lists all claims 23-43 which are inclusive of the claims 23, 25, 30,

32 and 37 on appeal. They are rejected under 35 U.S.C. § 103 as being

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unpatentable over Schier further in view of well-known prior art.

Rather than repeat the positions of the appellants' and the examiner, reference is made to the brief and reply brief for the appellants' positions, and to the answer for the examiner's positions.

#### **OPINION**

We reverse both stated rejections of the respective claims on appeal.

We reverse the rejection of claims 25 and 32 under the second paragraph of 35 U.S.C. § 112. Independent claims 23 and 30, the parent claims to dependent claims 25 and 32, recite a feature of voice recognition which is more particularly recited in these respective dependent claims as comprising "speaker independent voice recognition."

The examiner takes the view at page 3 of the answer that voice recognition involves recognition of particular characteristics of a person's utterances, whereas speaker independent speech recognition does not recognize particular characteristics of a person's utterances. The examiner considers speaker independent voice recognition as being inapplicably recited in the two rejected claims and intends to interpret the feature of

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claims 25 and 32 as "speaker independent speech recognition." The examiner's responsive arguments at pages 7 and 8 of the answer make reference to the substance of the comments at page 2 of the Advisory Action, mailed on April 17, 2003. Here, the examiner characterizes the term "voice recognition" as denoted by determining who is doing the speaking, whereas "speech recognition" denotes identification of what a speaker is saying.

In reversing the rejection of claims 25 and 32, we agree with appellants' views expressed at pages 14-16 of the principal brief on appeal. Appellants' characterization of "voice recognition" in independent claims 23 and 30 is consistent with the manner in which the term is used in the specification as filed. The approach claimed and the principal approach taught in the specification as filed is to initially identify users based upon voice recognition software and then to narrow the initial general class of potential users to a reasonable number which is in turn further modified with other information to particularize to an individual user. The approach does not necessarily require the use of content recognition or speech recognition software as argued by the examiner, but voice recognition

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per se. This is done through the use of prestored voice prints recited in independent claims 23 and 30 on appeal.

As indicated at the bottom of page 15 of the principal brief on appeal, appellants have not used the term voice recognition within its particular recitation of speaker independent voice recognition in dependent claims 25 and 32 in any manner that is inconsistent with the accepted meanings in the art as evidenced by the definition attributed to the questioned term from Newton's Telecom Dictionary, 2003 Edition, page 640, which was attached to both the brief and reply brief. It appears that the definition of speaker independent voice recognition that appellants are using is the recognition of any user's voice without prior training or knowledge of the user even though appellants' ultimate aim in the claims and in the disclosure is to identify a particular user based on voice recognition.

We know of no reason why the appellants should be prohibited from using the technology of speaker independent voice recognition as part of their process. This approach is also used by the Schalk patent mentioned

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as part of the prior art beginning at specification page 2. From an artisan's perspective and from the public's perspective, we do not see that dependent claims 25 and 32 are either indefinite or otherwise deceptive in the state of the art, nor do we see that the appellants are not particularly pointing out and distinctly claiming in these claims what they regard as their invention. Therefore, the rejection of claims 25 and 32 under the second paragraph of 35 U.S.C. § 112, is reversed.

We also reverse the rejection of claims 23, 25, 30, 32 and 37 under 35 U.S.C. § 103 as being unpatentable over Schier in view of well-known prior art for essentially two reasons. Initially, we note that the examiner recognizes that Schier does not teach the feature recited in each of the independent claims 23, 30 and 37 "responsive to the voice recognition technique, selecting from the first plurality of users a second plurality of users, smaller than the first plurality of users by a factor of at least 10." The examiner then utilizes Official Notice of well-known voice recognition systems which reduce recognized persons from an initial list of persons at least by a factor of ten. From this recognition, we conclude the examiner has failed to establish a *prima facie* case of obviousness.

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We are constrained to reverse the outstanding rejections because initially there is no evidence before us of this feature in the reference relied upon by the examiner in formulating the rejection. We reach this conclusion based upon the reasoning provided by recent cases from our reviewing court. "[T]he Board cannot simply reach conclusions based on its own understanding or experience - or on its assessment of what would be basic knowledge or common sense. Rather, the Board must point to some concrete evidence in the record in support of these findings." In re Zurko, 258 F.3d 1379, 1386, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001). See also In re Lee, 277 F.3d 1338, 1344-45, 61 USPQ2d 1430, 1434-35 (Fed. Cir. 2002). The court in Lee requires evidence for the determination of unpatentability by clarifying that "common knowledge and common sense," as mentioned in In re Bozek, 416 F.2d 1385, 1390, 163 USPQ 545, 549 (CCPA 1969), may only be applied to analysis of the evidence, rather than be a substitute for evidence. Lee, 277 F.3d at 1345, 61 USPQ2d at 1435. See Smiths Indus. Med. Sys., Inc., v. Vital Signs, Inc., 183 F.3d 1347, 1356, 51 USPQ2d 1415, 1421 (Fed. Cir. 1999)(Bozek's reference to common knowledge "does not in and of itself make it so" absent evidence

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of such knowledge).

Although we do not have before us an assertion of common knowledge and common sense in the art as in *In re Lee*, the examiner has made an analogous assertion that the noted feature was well-known to be used in the art. Correspondingly, the examiner's assertion appears to us to be a substitute for actual evidence to prove the examiner's assertion. More recently, the court expanded its reasoning in *In re Thrift*, 298 F.3d 1357, 1363-64, 63 USPQ2d 2002, 2007-08 (Fed. Cir. 2002).

The second reason we reverse this rejection is because part of the examiner's analysis in rejecting the claims under 35 U.S.C. § 103 has improperly utilized a reference not formally part of the rejection. The discussion at pages 9 and 10 of the responsive arguments portion of the answer indicates that the examiner had originally cited the Kanevsky reference in Paper No. 4, mailed on March 14, 2001, which was well before the rejection was made in the final rejection, Paper No. 16, mailed on December 2, 2002. In one of appellants' succeeding attempted amendments, Paper No. 20, filed on March 11, 2003, the examiner states in the paragraph bridging pages 9-10 of the answer that appellants asked

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to see the reference urged by the examiner that was not identified as part of the Official Notices assertions. This was revealed in the Advisory Office action mailed on April 17, 2003 as Paper No. 22 as a part of the discussion at page 2.

This file history makes it clear to us that the examiner has not utilized the Kanevsky reference in the formal statement of the rejection of the claims on appeal within 35 U.S.C. § 103 in the final rejection. It is the final rejection from which appellants appeal and not the Advisory Office action. The Kanevsky et al. reference mentioned in the arguments, but not recited in the statement of a rejection, will not be considered. "Where a reference is relied on to support a rejection, whether or not in a minor capacity, that reference should be positively included in the statement of the rejection." MPEP § 706.02(j) (quoting *In re Hoch*, 428 F.2d 1341, 1342 n.3, 166 USPQ 406, 407 n.3 (CCPA 1970). Accord *Ex parte Movva*, 31 USPQ2d 1027, 1028 n.1 (Bd. Pat. App. & Int. 1993) ; *Ex parte Raske*, 28 USPQ2d 1304, 1304-05 (Bd. Pat. App. & Int. 1993) ; *Ex parte Hiyamizu*, 10 USPQ2d 1393, 1394 (Bd. Pat. App. & Int. 1988).

From our perspective, the examiner is free to reinstitute any desired

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rejection under 35 U.S.C. § 103 including one relying upon Schier and Kanevsky in a formally stated rejection. The examiner should also consider the utilization of any other prior art including the Schalk patent mentioned as part of the prior art at specification pages 2 and 3 and the prior art inferences at specification pages 13 and 14.

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In view of the foregoing, the decision of the examiner rejecting claims 25 and 32 under the second paragraph of 35 U.S.C. § 112 is reversed. Likewise, the rejection of claims 23, 25, 30, 32 and 37 under 35 U.S.C. § 103 is also reversed. Therefore, the decision of the examiner rejecting various claims on appeal is reversed.

REVERSED

James D. Thomas )  
Administrative Patent Judge )  
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 ) BOARD OF PATENT  
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Administrative Patent Judge ) APPEALS AND  
 ) INTERFERENCES  
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